

REMARKSA. Period For Reply

A shortened statutory period for reply was set to expire three months from the mailing date of the Office Action of February 8, 2005. Three months from February 8, 2005 is May 8, 2005. May 8, 2005 falls on a Sunday. This Amendment and Remarks is thus being filed on or before Monday, May 9, 2005.

B. Status

The Office Action of February 8, 2005 was a non-final Office Action.

C. Disposition Of Claims

Claims 1, 10, 11, 12, and 43 are pending.

D. Application Papers

At the appropriate time, approval of the formal drawings would be very much appreciated.

E. Priority under 35 U.S.C. §§ 119 and 120

As to foreign priority, this case does not claim foreign priority.

As to domestic priority, this case does not claim domestic priority.

F. Attachments

Applicant has filed two PTO-1449 forms in this case, one with the filing of this case on January 18, 2002 and one on April 28, 2003. These PTO-1449 forms have been signed and all of the references listed on the forms have been initialed by the Patent Office. This is appreciated.

G. Basis for amendmentsG.1. Basis for amendments to the specificationG.1.a. First amendment to the specification

Paragraph [0032] of the specification has been amended as follows:

[0032] FIGS. 2A-D shows how strips of tape may be engaged to a face mask to form a ~~continuous~~ seal.

Basis for such amendment is two-fold. First, Figures 2A-D show strips of tape that overlap. Hence, the seal necessarily includes small gaps or breaks at the edges of a first strip that has been placed on top of a second strip. Thus, the use of "continuous" is contrary to the primary meaning of "continuous." Meanings of "continuous" as provided by The American Heritage® Dictionary of the English Language, Fourth Edition, Copyright © 2000 by Houghton Mifflin Company are:

- 1) Uninterrupted in time, sequence, substance, or extent.
- 2) Attached together in repeated units: a continuous form fed into a printer.
- 3) Mathematics. Of or relating to a line or curve that extends without a break or irregularity.

In the present specification, "continuous" was used in the second sense in paragraph [0032] (i.e., the strips of tape are attached as repeated units) and in the primary sense as to the "continuous band of skin."

Second, applicant has used "continuous" in the specification at all other locations in the primary sense (except for the disclosure as to flaking skin). All (it is respectfully believed pursuant to an electronic search) of the locations where "continuous" or a like term are used are:

- 1) "...a) cleaning a continuous band of skin that completely surrounds the nostrils and mouth; b)

removing hair from the continuous band of skin..."

Please see original claim 18.

- 2) "...the step of removing hair from the continuous band of skin..." Please see original claim 19.
- 3) "...a seal engagable between the face and the resilient piece at said opening of the resilient piece and runnable continuously around the eyes, nose and mouth as a whole..." Please see original claim 28.
- 4) The band of skin 14 is continuous. Please see page 8, lines 25-26.
- 5) Dead epithelial cells of the stratum corneum are continuously flaked off. Please see page 9, lines 26-27.
- 6) The seal 12 runs continuously from position A to position B to position C to position B to position A to run continuously about the eyes, nose and mouth as a whole. Please see page 22, lines 19-21.
- 7) "...the steps of cleaning a continuous band of skin that completely surrounds the nostrils and mouth, removing hair from the continuous band of skin..." Please see page 4, lines 23-25.
- 8) "...the step of removing hair from the continuous band of skin..." Please see page 4, lines 27-28.

The purpose of the above amendment to remove the term "continuously" where it is used with respect to the seal so that the claims are properly interpreted.

G.1.b. Second amendment to the specification

The second amendment to the specification is as follows:

Figures 1B, 7A, 7B, 8B, and 9 show an uninterrupted endless seal 12 that completely surrounds the nostrils and mouth.

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Figures 5A and 5B show the neutralizing agent 66 extending from a top side to a bottom side of the covering 16 and from a right side to a left side of the covering 16 such that any air passing through the covering 16 confronts the neutralizing agent 66.

Basis for such amendment is shown in section G.2. of this paper below. The purpose of this amendment is to place explicitly clear basis in the specification for the claims. No new matter has been presented either into the specification or into the claims.

G.2. Basis for amendments to the claims

Independent claim 1 has been amended to recite "a seal on an entirety of the periphery." Basis for this amendment is found at least in original claim 2 as filed with this application on January 18, 2002.

Independent claim 1 has further been amended to recite "with the seal being an uninterrupted endless seal that completely surrounds the nostrils and mouth."

Basis for "uninterrupted" is found at least at the following portions of the specification:

- 1) Figures 1B, 7A, 7B, 8B, and 9 that show an uninterrupted seal 12;
- 2) in line 2, page 15 where "absolute seal" is called out;
- 3) in line 12, page 15 where "perfect seal" is called out;
- 4) in line 14, page 15 where "perfect 360 degree tape" is called out; and
- 5) in lines 19-21, page 22, where it is disclosed that "The seal 12 runs continuously from position A to position B to position C to position B to position A to run continuously about the eyes, nose and mouth as a whole."

Basis for "endless" is found at least at the following portions of the specification:

- 1) Figures 1B, 7A, 7B, 8B, and 9 that show an endless seal 12;
- 2) Original claim 2 filed with this case on January 18, 2002 where it is disclosed that the "adhesive extends entirely about the periphery."
- 3) in line 14, page 15 where "perfect 360 degree tape" is called out; and
- 4) in lines 25-26, page 8 where it is disclosed that "The band of skin 14 is continuous."

Independent claim 12 has been amended to incorporate all of the limitations of, and thus finds basis in: a) independent claim 1 as amended; b) claim 40 (previously dependent upon independent claim 12 and now cancelled), c) claim 10 (dependent upon independent claim 1), and d) claim 11 (dependent upon independent claim 1).

Independent claim 12 has further been amended to recite "with the neutralizing agent extending from a top side to a bottom side of the covering and from a right side to a left side of said covering such that any air passing through said covering confronts the neutralizing agent." Basis for this limitation is found at least at the following portions of the specification: a) lines 3-6, page 18, b) Figure 5A where a top to bottom cross-section is shown, as described on page 7, line 21, and c) Figure 5B where a side to side cross section is shown, as described on page 7, line 22.

G.3. Basis for new claims

New independent claim 43 is presented.

Independent claim 43 includes all of the limitations of, and thus finds basis in: a) independent claim 1 as amended, and b) claim 33 (previously dependent upon independent claim 1 and now cancelled).

H. The Office Action

H.1. Section 1 of the Office Action

In section 1 of the Office Action, the restriction requirement was made final.

H.2. Section 2 of the Office Action

In section 2 of the Office Action, 35 U.S.C. 102 (b) was set out.

H.3. Sections 3-6 of the Office Action

In section 3 of the Office Action, claims 1 and 10 (and 12, please see section 6 of the Office Action) were rejected under 35 U.S.C. 102(b) as being anticipated by Hollander et al. (WO 99/65347). This rejection is respectfully traversed on the basis of applicant's discussion in section I. below.

In section 4 of the Office Action, independent claim 1 was discussed. Here the Patent Office stated that Hollander et al. teaches a periphery extending to a position on the front of the face below the lower lip and on the front of the chin. This is respectfully a misunderstanding by the Patent Office and is respectfully specifically traversed.

In section 6 of the Office Action, independent claim 12 was discussed. Here the Patent Office stated

that Hollander et al. teaches a periphery extending to a position on the front of the face below the lower lip and on the front of the chin. This is respectfully a misunderstanding by the Patent Office and is respectfully specifically traversed.

H.4. Sections 7-11 of the Office Action

In section 7 of the Office Action, 35 U.S.C. 103(a) was set out.

In sections 8-9 of the Office Action, claim 11 was rejected under 35 U.S.C. 103(a) as being unpatentable over Hollander et al. (WO 99/65347) in view of Braunoth (US 4,503,851). This rejection is respectfully traversed.

In sections 10-11 of the Office Action, claims 33 and 40 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hollander et al. (WO 99/65347) in view of Leise, Jr. et al. (US 6,740,067). This rejection is respectively traversed on the basis of applicant's discussion below.

I. Applicant's discussion

I.1. Independent claim 1

Applicant would like to highlight two features of the Hollander et al. reference because these two features show that there are two differences between independent claim 1 of applicant and the Hollander et al. reference.

I.1.a. First feature: the Hollander et al. "under the chin" feature

Please see Figure 9 of the Hollander et al. reference. This shows the Hollander et al. feature of "under the chin."

Figure 9 is described on page 5 of the Hollander et al. reference as follows: "Fig. 9 is an underside view of the mask of the invention attached to the face of a user."

In contrast, applicant positively claims that which is underlined below:

b) wherein the covering includes a periphery completely surrounding the nostrils and mouth, wherein the periphery is structured to extend from a first position on the bridge of the nose above the nostrils to the right side of the nose, from said right side of the nose to a position on the front of the face beyond the right side of the mouth, from said position beyond the right side of the mouth to a position on the front of the face below the lower lip and on the front of the chin, from said position below the lower lip to a position on the front of the face beyond the left side of the mouth, from said position beyond the left side of the mouth to the left side of the nose, from said left side of the nose back to said first position on the bridge of the nose such that the nostrils and mouth are completely surrounded;

It is respectfully submitted that independent claim 1 is not anticipated by Hollander et al. on the basis of this first difference.

Please note advantages of this first difference are not afterthoughts, as disclosed in the paragraph bridging pages 2-3 of the specification as filed:

Another feature of the present invention is the provision in a face mask having an adhesive seal, of the seal being placed in a position on the face where there is minimum movement when the wearer of the face mask talks or, more precisely, yells. The lower jaw especially moves when one yells, but the lower jaw "slips" within the skin of the face such that the skin of the face moves significantly less than the lower jaw. Of course, the skin of the underside of the lower jaw is greatly displaced, but not the skin of the face or the skin of the front of the face. Such a position on the face where there is such minimal movement of the skin is critical to the present passive face mask and such a position extends from a first position on the bridge of the nose above the nostrils to the right side of the nose, from said right side of the nose to a position on the front of the face beyond the right side of the mouth, from said position beyond the right side of the mouth to a position on the front of the face below the lower lip and on the front of the chin, from said position below the lower lip to a position on the front of the face beyond the left side of the mouth, from said position beyond the left side of the mouth to the left side of the nose, from said left side of the nose back to said first position on the bridge of the nose such that the nostrils and mouth are completely surrounded and such that the face mask is sealed where there

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is minimal movement of the skin of the face when the wearer yells.

I.2.b. Second feature: the Hollander et al. "slits in the periphery" feature

In discussing this second feature, please note that this second feature does not relate to element 24 indicated in Figure 1 of the Hollander et al. reference. Reference number 24 indicates outer peripheral edges of sealing sheets 4 and 6, which together constitute a pull apart package, having an air and water-tight cavity, for storing mask portion 2 until use. Please see page 8, lines 22-25.

This second feature relates to the element 10 indicated in Figure 1 of the Hollander et al. reference. Element 10 of Hollander et al. is an attachment lip 10 having a number of slits 14 cut therein. Specifically, Hollander et al. provides the following disclosure on page 8, lines 3-21:

Attachment lip 10 includes a number of slits 14 cut therein, as shown in Fig. 1, which may extend into mask 8 if desired. Slits 14 are provided in order to improve the fit of mask 8 on the face during use by preventing bunching of the mask due to the irregular facial features. Slits 14 permit the otherwise flat mask 8 to be fitted tightly to the face, as shown in Figs. 7-9. During use, the adhesive on attachment lip 10 is exposed, as discussed below. The mask is applied to the face, with flexible strip 12 being bent to secure the mask portion to the bridge of the nose. Attachment lip 10 includes upstanding portions 16 and 18, which are pressed against the cheeks for adhesive 20 to attach thereto. Upstanding portions 16 and 18 include one or more slits 14 extending therethrough, which become slightly overlapped when the mask is applied to the cheeks to adjust to the curvature and contour of the face (not shown in Figs. 7-9). Attachment lip 10 also includes a lateral portion 22, which is folded under the chin, and secured thereto by adhesive 20. In areas where bunching would normally occur, slits 14 are overlapped by the wearer to create a tight seal where attachment lip 10 is secured to the chin and cheeks. While flexible strip 12 provides a relatively tight fit of mask 8 to the bridge of the nose, if desired, attachment lip 10 may be extended laterally along the portion of the mask having flexible strip 12, thereby providing an adhesive attachment of the mask to the face along the entire periphery of the mask. If an attachment lip is not used, the slits may be cut in mask 8 itself.

The disclosure of the "overlapping of slits" makes it clear that the seal of Hollander et al. is not continuous. (Likewise, applicant's seal embodiment in Figures 2A, 2B, 2C and 2D is not continuous in the primary sense of continuous). "Overlapping" necessarily would result in small openings or breaks. The teaching of an "entire periphery" relates to placing the attachment lip 10 along the flexible strip 12 (for the bridge of the nose) such that the attachment lip 10 extends along or over the nose. Thus the teaching of an "entire periphery" does not cure the small openings or breaks that would necessarily result from overlapping.

In contrast to Hollander et al., applicant's claim 1 now positively recites as follows:

f) a seal on an entirety of the periphery, with the seal being an uninterrupted endless seal that completely surrounds the nostrils and mouth, wherein the seal includes an adhesive that sticks to skin to minimize an amount of substances that access the nostrils and mouth via a route between the periphery and the face and to maximize the amount of substances that are trapped by the covering.

It is therefore respectfully submitted that independent claim 1 is not anticipated by Hollander et al. on the basis of this second difference.

An advantage of the uninterrupted endless seal is that it is a perfect, absolute seal.

I.2. Independent claim 12

First, the above discussion is hereby incorporated by reference because independent claim 12 includes all of the limitations of independent claim 1. Thus, Hollander et al. does not anticipate claim 12 at least on the basis of the first and second differences discussed above.

Second, Hollander et al. does not anticipate, nor render obvious, claim 12 on the basis of third and fourth differences discussed below.

I.2.a. Third difference

Claim 11 has been incorporated into claim 12 such that claim 12 positively recites, as the neutralizing agent, activated charcoal. Claim 11 was rejected above as being unpatentable over Hollander et al. in view of Braunoth.

Claim 12 has further been amended to call out the following feature that is underlined below:

f) a neutralizing agent engaged to the covering where the covering is structured to permit air into the covering to maximize the chances that substances passing through the covering are rendered less harmful by the neutralizing agent, with the neutralizing agent extending from a top side to a bottom side of the covering and from a right side to a left side of said covering such that any air passing through said covering passes through the neutralizing agent;

g) wherein the neutralizing agent comprises activated charcoal;

Hollander et al., on page 7, lines 10-17, discloses the following:

Mask 8 is stored in a moistened condition, so that it will be immediately available for use by a user in a smoky condition. The mask is preferably moistened with water, either alone or in combination with other substances. In a preferred embodiment, mask 8 is also moistened with aloe, glycerin, and/or corn syrup, alone or in desired combinations. These substances are preferred to minimize the likelihood of face chapping when using the mask. Alternatively, various other substances, such as those disclosed in U.S. Patent No. 5,322,060, may be utilized within the mask to neutralize the smoke, to filter particulates, or to serve any other useful function.

Braunoth discloses envelope 22 (in Figure 2) and envelope 52 (in Figure 5). Each of the envelopes 22, 52 have an odor-masking substance. Each of the envelopes 22, 52 is on only a portion of the mask and does not extend to either the right side, or the left side, or the top side, or the bottom side of the mask.

As to the combination of the Hollander et al. and Braunoth references, it is respectfully submitted that:

- Hollander et al. does not teach how to place a neutralizing agent that is a solid (such as

activated charcoal) across the entire mask where air must confront such. It can only be presumed that the moisture of Hollander et al. (water, aloe, glycerin, corn syrup) may (or may not) be wicked throughout the mask; and

- Braunoth does not teach how to place a neutralizing agent, either a solid or liquid, across the entire mask where air must confront such. Instead, as discussed above, the envelope of Braunoth is on only a portion of the mask.

Therefore, even if the references are combined, such a combination does not teach the third difference of applicant's independent claim 12. It is respectfully submitted that independent claim 12 is allowable on the basis of this third difference.

An advantage of this third difference complements the advantage of the second difference. Air carrying toxic substances cannot pass through the uninterrupted endless seal. Such air must confront the activated charcoal. Please see lines 2-4 of page 1 of the specification: "The present invention relates...specifically to a sealed face mask having multiple features to maximize chances of survival." Please see the advantage (that is not an afterthought) disclosed on page 6, lines 3-8 of the specification as filed:

Another advantage of the present invention is that the periphery about the face mask is no longer the path of least resistance to air; air must now pass through the face mask where the face mask is structured to permit the air to pass. Accordingly, since the route of passage of air is now controlled, a neutralizer may be placed at the controlled entrance. Hence, the chances are maximized that 100% of the air that is breathed is neutralized.

I.2.b. Fourth difference

Dependent claim 40 (now cancelled) has been incorporated into claim 12 such that claim 12 positively

recites, as the adhesive, styrene-olefin-styrene block copolymer. Claim 40 was rejected above as being unpatentable over Hollander et al. in view of Leise, Jr. et al.

Claim 12 thus now calls out the following limitation:

i) wherein the adhesive comprises a styrene-olefin-styrene block copolymer.

Leise, Jr. et al. relates to a Reformable Convex Adapter For Ostomy Appliance.

The utilization of a teaching from a reference directly related to an ostomy appliance is, it is respectfully submitted, a teaching by applicant. Please see page 12, lines 24-25, where applicant incorporated by reference the ostomy related Poulsen et al. U.S. Patent No. 4,367,732. Please also see applicant's Amendment and Remarks of August 26, 2004 where such patent was incorporated by reference.

Applicant took the teaching of an adhesive related to ostomies and applied such to face masks. The Patent Office, having the teachings of applicant, now applies the Leise, Jr. et al. ostomy related reference against applicant. In other words, it is respectfully submitted that the Patent Office followed the road map invented by applicant.

In yet other words, the following combination is a unique combination developed by applicant:

- the selection of a face mask with a seal; and
- the selection of an ostomy related adhesive for the seal of the face mask.

Applicant, not the Patent Office, found in the ostomy art a teaching that is advantageous in an art related to the mouth and nose.

Therefore, even if the Hollander et al. and Leise, Jr. et al. references are combined, such a combination does not teach the fourth difference of applicant's independent claim

12. It is respectfully submitted that independent claim 12 is allowable on the basis of this fourth difference.

I.3. Independent claim 43

Consideration of new independent claim 43 would be appreciated.

As to independent claim 43, this claim includes all of the limitations of independent claim 1 and further includes the limitation of:

i) wherein the adhesive comprises a styrene-olefin-styrene block copolymer.

Accordingly, the above discussions as to the first, second and fourth differences are hereby incorporated by reference.

Thus, it is respectfully submitted that independent claim 43 is allowable on the basis of each of the first, second and fourth differences considered independently of each other.

I.4. Summary

Independent claim 1 is allowable on the basis of two separate and independent differences.


Independent claim 12 is allowable on the basis of four separate and independent differences.

Independent claim 43 is allowable on the basis of three separate and independent differences.

The Examiner is respectfully invited to make contact with the undersigned by telephone if such would advance prosecution of this case.

Respectfully submitted,

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